

80216
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bruce A. Fogelson Art Unit: 3688
Serial No.: 09/885,970 Conf. No.: 5291
Filed: June 21, 2001 Examiner: Janvier, J.
For: METHOD AND SYSTEM FOR
CREATING ADVERTISEMENT BOOKS
Attorney
Docket No.: 80216

APPELLANT'S BRIEF UNDER 37 CFR §41.37

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final rejection of September 18, 2009 and in support of the applicant's Notice of Appeal filed November 30, 2009, the applicant requests consideration of the following:

I. Real Party in Interest.

The real party in interest is Bruce A. Fogelson.

II. Related Appeals and Interferences.

None.

III. Status of Claims.

Claim 1 has been objected to. Claim 28 stands rejected under 35 U.S.C. §101 and §112. Claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. Publ. No. US 2002/0188532 to Rothstein. Claims 10-11 and 38-39 stand rejected as being obvious over the combination of Rothstein with subject matter deemed to be “common practice in the art of computer technology,” pursuant to “Official Notice” taken by the Examiner.

IV. Status of Amendments.

The claims have not been amended since the final Office Action of September 18, 2009.

V. Summary of Claimed Subject Matter.

The claimed invention is directed to a system and method for producing ad books. In this regard, “Advertisement books (used herein as “ad-books”) are fundraising vehicles whereby members and supporters of an organization pay the organization to place an advertisement (used herein as “ad”) or message in an organization’s publication for the dual purpose of advertising and contributing to the group” (specification, page 1, second full paragraph). Moreover, “Although ad-book ads are viewed by advertisers as a deductible business expense, the “advertiser’s” primary economic motivation is to make a contribution to the organization as opposed to receiving quality or

value for a purchase" (specification, paragraph bridging pages 1-2).

Claim 1 is directed to "A method for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations, for charity or fund raising, whereby members or supporters of the organization publish or place or manage an ad or ads or a message or messages in the organization's publication, such method comprising: ..." A method of computerized/automated preparation, publication, publishing and management of ad-books and related print and publishing used by or for recognized non-for-profit organizations, for charity or fund raising whereby members or supporters of the organization publish or place or manage an ad or ads or a message or messages in the organization's publication, such method comprising is described, in general, throughout the specification (*See e.g.*, p.3 of specification - third and fourth full paragraphs), and is shown in FIGs. 1-5.

Claim 1 is further directed to the step of "a member, supporter or contributor at a user terminal connected to a communications network accessing an advertising preparation tool or computer program within an ad-book server or communication network." The step of a member, supporter or contributor at a user terminal 2, 4 accessing an advertising preparation tool or computer program within an ad-book server 6 or communication network 10 is described in the paragraph bridging pages 6-7 of the specification and is shown in FIGs. 1-4.

Claim 1 is further directed to "the member, supporter or contributor preparing an ad or message using the advertising preparation tool or computer program." The step of the member, supporter or contributor preparing an ad or messages using the advertising preparation tool or

computer program is described in the specification in the paragraph bridging pages 6-7 of and continuing to the end of the first full paragraph of page 8, and is further shown in FIG. 1.

Claim 1 is further directed to “receiving a pledge or contribution from the member, supporter or contributor on behalf of the recognized not-for-profit organization.” The receipt of a pledge or contribution from the member, supporter or contributor of the recognized not-for-profit organization is described throughout the specification (*See e.g.*, p.9 - last full paragraph).

Claim 1 is further directed to “processing the ad or message at the server connected to the communications network for placing the ad or message in an ad-book or related print publication where the ad-book or related print publication is a fundraising vehicle and the governmentally recognized not-for-profit organizations, members or supporters of the organization solicit for or place the ads or messages to make contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the governmentally recognized not-for-profit organization, its activities or its members or its mission or cause.” The processing of the ad or message at the server 6 is discussed in the first full paragraph of page 9 and is shown in FIG. 4 of the specification. The use of the ad as a fundraising vehicle is discussed in the first full paragraph of page 2 of the specification.

Soliciting or placing ads or messages to encourage others to make contributions to the organization is described in the last full paragraph on page 7 of the specification. At least some of the ads or messages in the ad-book or related print publication containing laudatory statements about an organization, its activities, its members or its mission or cause is generally described in the last full paragraph on page 7 of the specification.

Claim 2 further limits claim 1 to the context “wherein preparing further comprises selecting choices relating to the ad or message.” The step of preparing further comprising selecting choices relating to the ad or message is described in connection with the step of preparing in the last full paragraph on page 7 of the specification.

Claim 3 further limits claim 2 to the context “wherein choices comprise size, placement, color, price, background, font, image or layout.” Choices comprising size, placement, color, price, background, font, image or layout is described in the last full paragraph on page 7 of the specification.

Claim 4 further limits claim 2 to the context “wherein choices comprises indicating whether the ad or message shall be printed in a physical ad-book or related publication or shall be posted on an on-line ad-book posted on an Internet web site as opposed to a physically printed publication or wherein the choice comprises whether the ad or message shall be both printed in a physical ad-book or related print publication and also posted on-line on an Internet web site.” Choices comprising whether the ad or message shall be printed in a physical ad-book or related publication, or shall be posted on an on-line ad-book posted on an Internet web site as opposed to a physically printed publication, or wherein the choice comprises whether the ad or message shall be both printed in a physical ad-book or related print publication and also posted on-line on an Internet web site is described throughout the specification, such as for example, from the last full paragraph on page 7 to the second full paragraph on page 9, and the paragraph bridging pages 10 and 11.

Claim 5 further limits claim 1 to the context “wherein preparing further comprises selecting an advertisement type or theme to reduce the number of choices that an advertiser must

make to produce an ad or message.” The step of preparing further comprising selecting an advertisement type or theme to reduce the number of choices that an advertiser must make to produce an ad or message is described in the first full paragraph on page 8 of the specification.

Claim 6 further limits claim 1 to the context “wherein the communications network comprises a public switch telephone network and packet data network.” A communications network 10 comprising a public switch telephone network and packet data network is described in the first full paragraph of the section titled “Detailed Description” on page 4 of the specification.

Claim 7 further limits claim 1 to the context “wherein the user terminal comprises a computer system.” The user terminal 2, 4 comprising a computer system 12, 14, 16, 18 is described in the second full paragraph on page 5 of the specification and is shown in FIGs 1-2.

Claim 8 further limits claim 7 to the context “wherein the computer system comprises one of a personal computer, a notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant.” The computer system 12, 14, 16, 18 comprising one of a personal computer, a notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant is described in the second full paragraph on page 5 of the specification.

Claim 9 further limits claim 1 to the context “wherein the server comprises a web server computer system for accessing the communications network.” The server 6 comprising a web server computer system for accessing the communications network 10 is described in the second full paragraph on page 5 of the specification and is shown in FIGs 1-2.

Claim 10 further limits claim 9 to the context “wherein the web server comprises a firewall for maintaining security.” The web server comprising a firewall 34 for maintaining security

is described in the second full paragraphs on pages 6 and 10 of the specification, and is shown in FIG. 3.

Claim 11 further limits claim 10 to the context “wherein the firewall limits access to information on the server wherein information comprises the ads or message and the ad-books.” The firewall 34 limiting access to information on the server wherein information comprises the ads or message and the ad-books is described in the second full paragraph on page 10 of the specification and is shown in FIG. 3.

Claim 12 further limits claim 1 to the context “wherein preparing further comprises using computer software running at the user terminal to create an ad or message.” The step of preparing further comprising using computer software running at the user terminal 2, 4 to create an ad or message is described throughout the specification, such as for example, in the first full paragraph of the section titled “Detailed Description” on page 4 of the specification, the last full paragraph on page 5, the first full paragraph on page 6, and is further shown in FIGs 1-2.

Claim 13 further limits claim 12 to the context “wherein the computer software comprises at least one of Microsoft Office, Corel PageMaker and Adobe PhotoShop.” The computer software comprising at least one of Microsoft Office, Corel PageMaker and Adobe PhotoShop is described in the first full paragraph on page 6 of the specification.

Claim 14 further limits claim 1 to the context “wherein processing further comprises receiving payment at the server for processing the ad or message for placement in an ad-book.” The step of processing further comprising receiving payment at the server 6 for processing the ad or

message for placement in an ad-book is described in the last full paragraph on page 9 of the specification.

Claim 15 further limits claim 1 to the context “wherein processing further comprises: receiving the ads or messages at the server from the user terminal; storing the ads or messages at the server; and converting the received ads or message into an ads or message to be placed into an ad-book or related print or publication.” The step of processing further comprising receiving the ads or messages at the server 6 from the user terminal 2, 4; storing the ads or messages at the server 6; and converting the received ads or message into an ads or message to be placed into an ad-book or related print or publication is described in the specification in the first full paragraph on page 6 through at least the paragraph bridging pages 6 and 7, and is further shown in FIGs. 1-3.

Claim 16 further limits claim 15 to the context wherein the method further comprises “receiving payment at the server for processing the ad or message for placement in an ad-book or related print or publication.” The method further comprising receiving payment at the server 6 for processing the ad or message for placement in an ad-book or related print or publication is described in the last full paragraph on page 9 of the specification.

Claim 17 further limits claim 15 to the context wherein the method further comprises “classifying the received ad or message into an ad-book or related print or publication category said classification based upon amount contributed to the recognized not-for-profit organization or by color of a page to be printed selected from the group consisting of gold, silver and white or by a size of the ad selected from the group consisting of full-page, one-half page, one-quarter page, business card size and simple listing of name or contact information.” The method further comprising

classifying the received ad or message into an ad-book or related print or publication category said classification based upon amount contributed to the recognized not-for-profit organization or by color of a page to be printed selected from the group consisting of gold, silver and white or by a size of the ad selected from the group consisting of full-page, one-half page, one-quarter page, business card size and simple listing of name or contact information is described in the first full paragraph on page 9 of the specification.

Claim 18 further limits claim 15 to the context wherein the method further comprises “using techniques, the techniques comprising statistics and demographics, to discern at least one group of related ads or messages said discernment based upon amount contributed to the recognized not-for-profit organization or by color of a page to be printed selected from the group consisting of gold, silver and white or by a size of the ad selected from the group consisting of full-page, one-half page, one-quarter page, business card size and simple listing of name or contact information.” The method further comprising using techniques comprising statistics and demographics, to discern at least one group of related ads or messages said discernment based upon amount contributed to the recognized not-for-profit organization or by color of a page to be printed selected from the group consisting of gold, silver and white or by a size of the ad selected from the group consisting of full-page, one-half page, one-quarter page, business card size and simple listing of name or contact information is described in the specification in the paragraph bridging pages 6 and 7 through at least the last full paragraph on page 8.

Claim 19 further limits claim 15 to the context wherein the method further comprises “using statistics and demographics, to discern at least one group of related organizations, members

or supporters which place ads or messages in ad-books or related print or publications.” The method further comprising using statistics and demographics, to discern at least one group of related organizations, members or supporters which place ads or messages in ad-books or related print or publications is described in the specification in the last full paragraph on page 8 through the second full paragraph on page 9.

Claim 20 further limits claim 15 to the context wherein the method further comprises “using statistics and demographics, to discern at least one group of related ad-books.” The method further comprising using statistics and demographics, to discern at least one group of related ad-books is described in the specification in the last full paragraph on page 8 through the second full paragraph on page 9.

Claim 21 further limits claim 15 to the context wherein the method further comprises “converting the received ‘ad’ or message into an HTML advertisement to be shown on at least one user terminal.” The method further comprising converting the received “ad” or message into an HTML advertisement to be shown on at least one user terminal is described in the first full paragraph on page 10 of the specification.

Claim 22 further limits claim 21 to the context wherein “the HTML ad or message is a part of an electronic ad-book.” The HTML ad or message being a part of an electronic ad-book is described in the first full paragraph on page 10 of the specification.

Claim 23 further limits claim 21 to the context wherein the method further comprises “sending a copy of the HTML ad or message to a member or supporter whom initiated the ad or message preparation.” The method further comprising sending a copy of the HTML ad or message

to a member or supporter whom initiated the ad or message preparation is described in the first full paragraph on page 10 of the specification.

Claim 24 further limits claim 1 to the context wherein the method further comprises “registering with the server whereby a member or supporter at the user terminal connects to the server and enters information relating to the member or supporter.” The method further comprising registering with the server 6 whereby a member or supporter at the user terminal 2, 4 connects to the server 6 and enters information relating to the member or supporter is described in the specification in the paragraph bridging pages 6 and 7, and is further shown in FIG. 4.

Claim 25 further limits claim 1 to the context wherein the method further comprises “entering a mode of payment at the user terminal to pay for the ad or message to be placed in the ad-book or related print or publication.” The method comprising entering a mode of payment at the user terminal 2, 4 to pay for the ad or message to be placed in the ad-book or related print or publication is described in the last full paragraph on page 9 of the specification.

Claim 26 further limits claim 1 to the context wherein the method further comprises “sending an acknowledgement to a member and/or supporter who places an ad or message in an ad-book or related print or publication notifying the member or supporter of the receipt of the ad or message.” The method comprising sending an acknowledgement to a member and/or supporter who places an ad or message in an ad-book or related print or publication notifying the member or supporter of the receipt of the ad or message is described in the first full paragraph on page 10 of the specification.

Claim 27 further limits claim 1 to the context wherein the method further comprises “sending an acknowledgement to a member or supporter who places an ad or message in an ad-book or related print or publication notifying the member or supporter of payment information.”

The method comprising sending an acknowledgement to a member or supporter who places an ad or message in an ad-book or related print or publication notifying the member or supporter of payment information is described in last full paragraph on page 9 of the specification.

Claim 28 is directed to “[a] method for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations for charity or fund raising, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization’s publication.” A method of computerized/automated preparation, publication, publishing and management of ad-books and related print and publishing used by or for recognized non-for-profit organizations, for charity or fund raising whereby members or supporters of the organization publish or place or manage an ad or ads or a message or messages in the organization’s publication, such method comprising are described, in general, throughout the specification (see e.g., third and fourth paragraphs of page 3) and is shown in FIGs. 1-5.

Claim 28 is further directed to “a member, supporter or contributor at a user terminal connected to a communications network accessing an advertising preparation tool or computer software system within a server or communication network.” The accessing of an ad book server 6 by a member, supporter or contributor at a user terminal 2, 4 connected to a communications network 10 is discussed in general throughout the specification (e.g., first two paragraphs of the

section titled “Detailed Description” on page 4 of the specification). The step of a member, supporter or contributor at a user terminal 2,4 accessing an advertising preparation tool or computer program within an ad-book server 6 or communication network is described in the paragraph bridging pages 6-7 and following paragraph and are shown in FIGs. 1-4.

Claim 28 is further directed to “the member, supporter or contributor preparing an ad or message by selecting choices provided by the advertising preparation tool or computer software system related to the ad or message.” The step of the member, supporter or contributor preparing an ad or messages using the advertising preparation tool or computer program is described beginning in the paragraph bridging pages 6-7 and continuing to the end of the first full paragraph of page 8, and is shown in FIGS 1-2.

Claim 28 is further directed to “receiving the prepared ad or message at the server connected to the communications network.” The receipt of a prepared ad or message at the server 6 connected to the communication network 10 is discussed in the first full paragraph of page 9, and is shown in FIG. 1.

Claim 28 is further directed to “classifying the prepared ad or message into at least one ad-book.” The classification of the prepared ad or message into at least one ad-book is discussed in the first full paragraph of page 9.

Claim 28 is further directed to “means for receiving a contribution from the contributor on behalf of the governmentally recognized not-for-profit organization.” The last full paragraph of page 9 discusses receipt of a contribution from the contributor on behalf of the governmentally recognized not-for-profit organization by the server 6.

Claim 28 is further directed to “converting the prepared ad or message into an ad or message to be placed into an ad-book or related print publication where the ad-book or related print publication is a fundraising vehicle and the recognized not-for-profit organization’s members or supporters of the organization solicit for or place the ads or messages to make financial pledges or contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the recognized not-for-profit organization, its activities or its members.” The converting of the prepared ad or message into an add or message to be placed into an ad-book or related publication is discussed in the first full paragraph of page 9. The use of the ad-book as a fundraising vehicle is discussed in the first full paragraph of page 2. The solicitation for ads to make financial pledges or contributions to the organization is discussed in the second full paragraph of page 1. The use of laudatory statements in the ad-book or related print publications is discussed in the first full paragraph of page 7.

Claim 29 is directed to “[a] system for preparing computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations for charity or fund raising and as a fundraising tool, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization’s publication.” A system for preparing computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations for charity or fund raising and as a fundraising tool, whereby organizations, members or supporters of the organization place or manage ads or messages in the

organization's publication is described in general, throughout the specification (see e.g., third and fourth paragraphs of page 3) and is shown in FIGs. 1-5.

Claim 29 is further directed to "an advertising preparation tool or software program within an ad-book server accessible by a contributor through a communication network." An advertising preparation tool or software program within an ad-book server 6 accessible by a contributor through a communication network 10 is described in the paragraph bridging pages 6-7 and following paragraph and are shown in FIGs. 1-4.

Claim 29 is further directed to "means used by the contributor for preparing an ad or message at a user terminal connected to the advertising preparations tool or software program through the communications network." Means used by the contributor for preparing an ad or message at a user terminal 2, 4 connected to the advertising preparations tool or software program through the communications network 10 is described in the paragraph bridging pages 6-7 and following paragraph and are shown in FIGs. 1-4.

Claim 29 is further directed to "means for receiving a financial pledge or contribution from the contributor on behalf of the recognized not-for-profit organization." Means for receiving a financial pledge or contribution from the contributor on behalf of the recognized not-for-profit organization is described in the last full paragraph of page 9 of the specification.

Claim 29 is further directed to "means for processing the ad at a server connected to the communications network for placing the advertisement in the ad-book or related print publication where the ad-book or related print publication is primarily a fundraising vehicle and the recognized not-for-profit organizations, members or supporters of the organization solicit for or place the ads or

messages to make pledges or contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the recognized not-for-profit organization, its activities or its members or cause or mission.” Means for processing the ad at a server 6 connected to the communications network 10 for placing the advertisement in the ad-book or related print publication is discussed in the first full paragraph of page 9 of the specification. The ad-book or related print publication is primarily a fundraising vehicle is discussed in the first full paragraph of page 2 of the specification. The recognized not-for-profit organizations, members or supporters of the organization solicit for or place the ads or messages to make pledges or contributions to the organization is discussed in the second full paragraph on page 1 of the specification. At least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the recognized not-for-profit organization, its activities or its members or cause or mission is discussed in the first full paragraph of page 7 of the specification.

Claim 30 further limits claim 29 to the context “wherein the means for preparing further comprises means for selecting choices relating to the ad or message.” Means for preparing further comprising means for selecting choices relating to the ad or message is described in the last full paragraph on page 7 of the specification.

Claim 31 further limits claim 30 to the context “wherein choices comprises size, price, placement, background and layout.” Choices comprising size, price, placement, background and layout is described in the last full paragraph on page 7 of the specification.

Claim 32 further limits claim 30 to the context “wherein choices comprises indicating whether the ad or message shall be printed in a physical ad-book or related print or publication or shall be posted on an on-line ad-book posted on an Internet web site as opposed to physically printed publication or wherein the choice comprises whether the ad or message shall be both printed in a physical ad-book or related print or publication and also posted on-line on the Internet web site in an on-line ad-book.” Choices comprising indicating whether the ad or message shall be printed in a physical ad-book or related print or publication or shall be posted on an on-line ad-book posted on an Internet web site as opposed to physically printed publication or wherein the choice comprises whether the ad or message shall be both printed in a physical ad-book or related print or publication and also posted on-line on the Internet web site in an on-line ad-book is described throughout the specification, such as for example, from the last full paragraph on page 7 to the second full paragraph on page 9, and the paragraph bridging pages 10 and 11.

Claim 33 further limits claim 29 to the context “wherein the means for preparing further comprises means for selecting an ad or message type, price or theme to reduce the number of choices that a member or supporter makes to produce an ad or message.” Means for preparing further comprising means for selecting an ad or message type, price or theme to reduce the number of choices that a member or supporter makes to produce an ad or message is described in the first full paragraph on page 8 of the specification.

Claim 34 further limits claim 29 to the context “wherein the communications network comprises a public switch telephone network and packet data network.” The communications network comprising a public switch telephone network and packet data network is

described in the first full paragraph of the section titled “Detailed Description” on page 4 of the specification.

Claim 35 further limits claim 29 to the context “wherein the user terminal comprises a computer system.” The user terminal 2, 4 comprising a computer system is described in the second full paragraph on page 5 of the specification and is shown in FIGs 1-2.

Claim 36 further limits claim 35 to the context “wherein the computer system comprises one of a personal computer, notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant.” The computer system comprising one of a personal computer, notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant is described in the second full paragraph on page 5 of the specification.

Claim 37 further limits claim 29 to the context “wherein the server comprises a web server computer system for accessing the communications network.” The server 6 comprising a web server computer system for accessing the communications network 10 is described in the second full paragraph on page 5 of the specification and is shown in FIGs 1-2.

Claim 38 further limits claim 37 to the context “wherein the web server comprises a firewall for maintaining security.” The web server comprising a firewall 34 for maintaining security is described in the second full paragraphs on pages 6 and 10 of the specification, and is shown in FIG. 3.

Claim 39 further limits claim 38 to the context “wherein the firewall limits access to information on the server wherein information comprises the ads or message and ad-books or related print or publication.” The firewall 34 limiting access to information on the server wherein

information comprises the ads or message and the ad-books is described in the second full paragraph on page 10 of the specification and is shown in FIG. 3.

Claim 40 further limits claim 29 to the context “wherein the means for preparing further comprises means for using computer software to create an ad or message.” Means for preparing further comprising means for using computer software to create an ad or message is described throughout the specification, such as for example, in the first full paragraph of the section titled “Detailed Description” on page 4 of the specification, the last full paragraph on page 5, the first full paragraph on page 6, and is further shown in FIGS 1-2.

Claim 41 further limits claim 40 to the context “wherein the computer software comprises at least one of Microsoft Office, Corel PageMaker and Adobe PhotoShop.” Computer software comprising at least one of Microsoft Office, Corel PageMaker and Adobe PhotoShop is described in the first full paragraph on page 6 of the specification.

Claim 42 further limits claim 29 to the context “wherein the means for processing further comprises receiving payment at the server for processing the ad or message for placement in an ad-book or related print or publication.” Means for processing further comprising receiving payment at the server for processing the ad or message for placement in an ad-book or related print or publication is described in the last full paragraph on page 9 of the specification.

Claim 43 further limits claim 29 to the context wherein the system further comprises “means for converting the ad or message into an HTML ad or message to be shown on at least one user terminal.” The system further comprising means for converting the ad or message into an

HTML ad or message to be shown on at least one user terminal is described in the first full paragraph on page 10 of the specification.

Claim 44 further limits claim 43 to the context “wherein the HTML ‘ad’ or message is a part of an electronic ad-book or related print or publication.” The HTML “ad” or message being part of an electronic ad-book or related print or publication is described in the first full paragraph on page 10 of the specification.

Claim 45 further limits claim 43 to the context wherein the system further comprises “means for sending a copy of the HTML ad or message to an a member or supporter whom initiated the ‘ad’ or message solicitation or preparation.” The system further comprising means for sending a copy of the HTML ad or message to an a member or supporter whom initiated the “ad” or message solicitation or preparation is discussed in the first full paragraph on page 10 of the specification.

Claim 46 further limits claim 29 to the context wherein the system further comprises “means for registering with the server whereby a member or supporter at the user terminal connects to the server and enters information relating to the member or supporter.” The system further comprising means for registering with the server 6 whereby a member or supporter at the user terminal 2, 4 connects to the server 6 and enters information relating to the member or supporter is described in the specification in the paragraph bridging pages 6 and 7, and is further shown in FIG. 4.

Claim 47 further limits claim 29 to the context wherein the system further comprises “means for receiving the ad or message from a member or supporter.” The system further

comprising means for receiving the ad or message from a member or supporter is described in the first full paragraph of the section titled “Detailed Description” on page 4 of the specification

Claim 48 further limits claim 47 to the context wherein the system further comprises “means for sending an acknowledgement to the member or supporter notifying the member or supporter of the receipt of the ad or message.” The system further comprising means for sending an acknowledgement to the member or supporter notifying the member or supporter of the receipt of the ad or message is described in the first full paragraph on page 10 of the specification.

Claim 49 further limits claim 47 to the context wherein the system further comprises “means for sending an acknowledgement to the member or supporter notifying the member or supporter of payment information.” The system further comprising means for sending an acknowledgement to the member or supporter notifying the member or supporter of payment information is described in last full paragraph on page 9 of the specification.

Claim 50 is directed to “[a] system for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for a recognized not-for-profit organization[[s]], for charity or fund raising, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization’s publication over the Internet.” A system for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for a recognized not-for-profit organizations, for charity or fund raising, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization’s publication

over the Internet is described in general, throughout the specification (see e.g., third and fourth paragraphs of page 3) and is shown in FIGs. 1-5.

Claim 50 is further directed to “a computer system comprising a user interface to a communications network and an advertising preparation tool within an ad-book server accessed by the user interface through the communications network to prepare an ad or message and to receive a contribution on behalf of the organization.” A computer system comprising a user interface to a communications network and an advertising preparation tool within an ad-book server accessed by the user interface through the communications network to prepare an ad or message and to receive a contribution on behalf of the organization is described in the paragraph bridging pages 6-7 and following paragraph and are shown in FIGs. 1-4.

Claim 50 is further directed to “the ad-book server connected to the communications network that receives the prepared ad or message for an ad-book or related print or publication where the ad-book or related print publication is a fundraising vehicle and the organizations, members or supporters of the recognized not-for-profit organization solicit for or place the ads or messages to make contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the governmentally recognized not-for-profit organization, for charity or fund raising, its activities or its members.” The ad-book server 6 being connected to the communications network 10 that receives the prepared ad or message for an ad-book or related print or publication is discussed in the first full paragraph of page 9 of the specification. The ad-book or related print publication being a fundraising vehicle is discussed in the first full paragraph of page 2 of the specification.

Organizations, members or supporters of the recognized not-for-profit organization soliciting or placing ads or messages to make contributions to the organization is discussed in the second full paragraph on page 1 of the specification. At least some of the ads or messages in the ad-book or related print publication containing laudatory statements about the governmentally recognized not-for-profit organization, for charity or fund raising, its activities or its members is discussed in the first full paragraph of page 7 of the specification.

Claim 51 further limits claim 50 to the context “wherein the computer system further comprises a graphical user interface for selecting choices relating to the ad or message.” The computer system further comprising a graphical user interface for selecting choices relating to the ad or message is described in the last full paragraph on page 7 of the specification.

Claim 52 further limits claim 51 to the context “wherein choices comprises size, placement, color, price, background, and layout.” Choices comprising size, placement, color, price, background, and layout is described in the last full paragraph on page 7 of the specification.

Claim 53 further limits claim 50 to the context “wherein the ad-book server presents choices relating to an ad or message type or ad or message theme to the computer system.” The ad-book server presenting choices relating to an ad or message type or ad or message theme to the computer system is described in the first full paragraph on page 8 of the specification.

Claim 54 further limits claim 50 to the context “wherein the communications network comprises a public switch telephone network and packet data network.” The communications network comprising a public switch telephone network and packet data network is

described in the first full paragraph of the section titled “Detailed Description” on page 4 of the specification.

Claim 55 further limits claim 50 to the context “wherein the computer system further comprises one of a personal computer, a notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant.” The computer system further comprising one of a personal computer, a notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant is described in the second full paragraph on page 5 of the specification.

Claim 56 further limits claim 50 to the context “wherein the ad-book server further comprises a web server computer system capable of interfacing with the Internet.” The ad-book server further comprising a web server computer system capable of interfacing with the Internet is described on page 5 of the specification and is shown in FIGs 1-2.

Claim 57 further limits claim 50 to the context “wherein the computer system further comprises at least one of Microsoft Office, Corel PageMaker, and Adobe PhotoShop.” The computer system further comprising at least one of Microsoft Office, Corel PageMaker, and Adobe PhotoShop is described in the first full paragraph on page 6 of the specification.

Claim 58 further limits claim 50 to the context “wherein the ad-book server further comprises a database of at least one of ads or messages, ad-books or related print or publications, and organizations, members or supporters.” The ad-book server further comprising a database of at least one of ads or messages, ad-books or related print or publications, and organizations, members or supporters is described in the second full paragraph on page 6 of the specification.

VI. Grounds of Rejection to be Reviewed on Appeal.

The rejection of claim 28 under 35 U.S.C. §101 and §112 is appealed. The rejection of claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 under 35 U.S.C. §103(a) as being obvious over U.S. Pat. Publ. No. US 2002/0188532 to Rothstein is appealed. The rejection of claims 10-11 and 38-39 as being obvious over the combination of Rothstein with subject matter deemed to be “common practice in the art of computer technology,” pursuant to “Official Notice” taken by the Examiner is appealed.

VII. Argument.

A. REJECTIONS UNDER 35 U.S.C. §101

Claim 28 stands rejected under 35 U.S.C. §101. According to 35 U.S.C. § 101,

[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

According to the Examiner, claim 28 is rejected under 35 U.S.C. § 101 because “the claimed invention is directed to non-statutory subject matter” to the extent that the “steps are neither tied to a ‘particular machine’ (such as a particular apparatus), nor do they physically transform the underlying subject matter (such as an article or materials) to a different state or thing.” (9/18/2009 Office Action, p.6-7). Specifically, the Examiner concludes that “the presence of a ‘particular machine’ is inserted in a non-significant step and thus, it cannot be used to overcome the 101 rejection.” (*Id.*).

Applicant respectfully traverses the pending §101 rejection. Contrary to the

Examiner's position, claim 28 does in fact recite statutory subject matter based on two separate and distinct basis. First, the recited steps physically transform the underlying subject matter to a different state or thing. For instance, claim 28 recites in-part "preparing an ad or message," and "converting the prepared ad or message into an ad or message to be placed into an ad-book." (emphasis added). These limitations plainly recite a process whereby a contributor's advertisement are physically transformed into a form of ad or message that is suitable for being placed in an ad-book. Accordingly, claim 28 satisfies the physical transformation test and recites statutory subject matter.

Claim 28 also satisfies §101 because the claimed method is specifically tied to a particular machine or apparatus. For instance, claim 28 recites the step of "receiving the prepared ad or message at the server connected to the communications network." (emphasis added). The specification discloses that the "server," according to various embodiments:

includes a monitor 26, a keyboard 30, a mouse 28, a processing unit 24, and network access 35 with a firewall 34 to the communications network 10. The web server may also include a floppy disk, a CD-ROM drive, read-only-memory, a modem, speakers, a camera, a zip drive and a laser printer 32.

(See p.6, second full paragraph).

In addition, the specification also discloses that:

the communications network may include circuit switched telephony as used in public switch telephone networks (PSTN) or data packet networks adhering to Internet Protocol (IP), frame relay, or Asynchronous Transfer Mode (ATM) protocols.

(See p.4 , first full paragraph under section titled "Detailed Description").

The server and communications network recited by this limitation of claim 28 are thus clearly described as being physical machines. The pending rejection ignores this particular limitation

of claim 28, which can in no way be considered an insignificant step in a claim that is directed to “a method of computerized/automated preparation, production, publishing and management of ad-books.” (emphasis added).

For these reasons, claim 28 properly recites statutory subject matter as set out in 35 U.S.C. § 101. Accordingly, the pending rejection under § 101 has no merit and claim 28 should be allowed.

B. REJECTION UNDER 35 U.S.C. § 112

Claim 28 stands rejected under 35 U.S.C. §112, second paragraph. The second paragraph of 35 U.S.C. § 101 provides,

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

According to the Office Action, Claim 28 is rejected under §112, second paragraph because it is “confusing” to the extent that it recites “means for receiving contribution” (9/18/2010 Office Action, p.7). According to the Examiner, “a method claim cannot include a ‘means for’ function in this manner.” (*Id.*).

Applicant respectfully traverses the pending rejection under §112, second paragraph for multiple reasons. First, a determination that a particular claim is “confusing,” is not a proper basis for rejecting any claim under § 112, second paragraph. As identified above, the standard under § 112, second paragraph is that a claim must “particularly point out and distinctly claim” the subject matter recited therein. The pending rejection is improper because it does not set forth any facts that

demonstrate how claim 28 fails to “particularly point out and distinctly claim” the recited subject matter. Accordingly, the rejection under § 112, second paragraph is unsupported and thus improper.

Second, the Examiner’s statement regarding a purported restriction on the use of a means-plus-function limitation in a method claims is entirely unsupported and inconsistent with patent regulation and practice. The rejection specifically states “a method claim cannot include a ‘means for’ function in this manner.” The Examiner however, fails to cite any rule or other authority that supports this statement. Indeed, a number of authorities acknowledge that issued patents include method claims having means-plus-function limitations. *See e.g. J & M Corp. v. Harley-Davidson, Inc.*, 269 F.3d 1360, 1364 (Fed. Cir. 2001) (“The mere fact that a method claim is drafted with language parallel to an apparatus claim with means-plus-function language does not mean that the method claim should be subject to an analysis under § 112, paragraph 6.”); *J & M Corp. v. Harley-Davidson, Inc.*, 269 F.3d 1360, 1364 (Fed. Cir. 2001) (recognizing that “Claim 17, [of Reissue Pat. No. 34,525] which is a method claim, contains a nearly identical means-plus-function limitation [as claims 15 and 16].”).

For these reasons, the Examiner has failed to properly support the rejection to claim 28 under 35 U.S.C. § 112, second paragraph. Accordingly, the pending rejection has no merit and claim 28 should be allowed.

C. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. Publ. No. US 2002/0188532 to Rothstein. Claims 10-11 and 38-39 stand rejected as being obvious over the combination of Rothstein and subject matter deemed to

be “common practice in the art of computer technology,” pursuant to “Official Notice” taken by the Examiner.

According to the 9/18/2010 Office Action, Rothstein discloses “an apparatus and method for advertising in electronic documents (ad books)” (9/18/2009 Office Action, page 9). The Office Action claims that Rothstein teaches an “ad book” “having one or more ads crafted by advertisers or contributors and inserted therein, can be used for any purpose.” (*Id.*, p.10). However, the Examiner concedes that “Rothstein does not expressly disclose that the contributor or advertiser uses a preparation tool or software stored on a server to craft or create an ad that is to be inserted in the ad book and that the organization (publisher) uses the ‘ad book’, … as a fund raising vehicle by charging a fee to a supporter for agreeing to place or for placing an ad in the ad-book.” (*Id.*).

With respect to independent claims 1, 28, 29 and 50 of the subject application, the Examiner takes “Official Notice” that it is “common practice in the art” for an entity to raise funds on behalf of a non-profit or charitable organization using a plurality of well-known methods. (*Id.*). The Examiner additionally claims that “it is also common practice in the art” to allow an advertiser or an agent working on behalf of an advertiser to connect, over a network, to a server and download therefrom a tool or software used to craft or create one or more advertisements. (*Id.* at p.12).

Based on these conclusions, the Examiner has rejected claims 1, 28, 29 and 50 (including their dependent claims) because, according to the Office Action, “it would have been obvious to an ordinary skilled artisan, using or implementing the system of Rothstein at the time of the invention, to incorporate the above disclosure (“Official Notice”) with the system of Rothstein” so as to obtain the claimed subject matter.

With respect to claims 10-11 and 38-39, the Examiner has conceded that “Rothstein does not explicitly disclose that the web server comprises a firewall for maintaining security.” (*Id.*, p.14). The Examiner, however, states “it is common practice in the art of computer technology to use or install a firewall module (software) on a file server or local terminal to prevent unauthorized users from accessing the server or terminal.” (*Id.*, p.14-15). Based on this, the Examiner concludes that “it would have been obvious to an ordinary skilled artisan, using or implementing the system of Rothstein at the time of the invention, to incorporate the above disclosure (“Official Notice”) into the system of Rothstein so as to” obtain the claimed subject matter.

Applicant respectfully traverses these § 103(a) rejections. The Examiner has failed to establish a *prima facie* case of obviousness with respect to the rejected claims. Accordingly, the pending § 103(a) rejections to claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 is improper.

1. OBVIOUSNESS IN GENERAL

The Federal Circuit has continually held that the Examiner has the burden under 35 U.S.C. §103 of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). This burden may be satisfied only by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to the claimed invention. For example, as the Federal Circuit has held recently, as well as on numerous other occasions: “[t]here must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*,

supra, 24 USPQ2d at 1446.

Moreover, the mere fact that the prior art references could be modified in the manner proposed by the Examiner would not have made the modification obvious unless there is some motivation or suggestion in the prior art to do so. In re Gordon, 773 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), also see In re Fritch, 972 F.2d 1260, 23 USPQ2d 1781, 1783 (Fed. Cir. 1992) (The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification).

When making an assessment of the obviousness of the claimed invention, the prior art, viewed as a whole, must "suggest the desirability, and thus the obviousness, of making the combination." In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992), quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). Similarly, the Examiner, under §103, must consider the claimed subject matter "as a whole". In assessing the claimed subject matter "as a whole", the results and advantages of the claimed invention must be considered. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 143 (Fed. Cir. 1987).

It is incumbent upon the Examiner to demonstrate that the proposed combination of reference teachings is proper. Where no express teaching or suggestion is apparent from the references, the Examiner must establish, with evidence or reasoning, why one skilled in the art would have been led by the relevant teachings of the applied references to make the proposed combination. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); ACS Hospital System,

Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). When making an obviousness rejection, "[i]t is impermissible, however, simply to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template", In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

2. THE PENDING § 103(a) REJECTIONS ARE UNSUPPORTED

Examiner's application of Rothstein against the cited claims is highly tenuous.

First, Rothstein explicitly states that the claimed "invention is a computer-implemented method for advertising in electronic books" (Rothstein, par. [0006]). However, an ad book does not constitute advertising in an electronic book. Instead, the ads in an ad book are (for all practical purposes) the book itself.

In addition, according to Rothstein, "an electronic book 114 is received from a publisher 104 by a distributor 106 . . . collects electronic ads 112 from advertisers 102 and converts the electronic ads to the format of the electronic book 112 before insertion into the electronic book" (Rothstein, par. [0023]). In contrast, ad books do not use electronic content from publishers or combine electronic content from publishers with content from contributors.

It appears that the Office Action simply assumes that if a book contains ads, then (ergo) it must be an ad book. However, this assumption clearly misunderstands the conventional meaning in the art of the term "ad book."

For example, and as would be well known to those of skill in the art, an advertiser would place advertising in the Rothstein electronic book in order to take advantage of the

entertainment value provided by the electronic book. In contrast, an ad book has no intrinsic entertainment value.

Moreover, independent claims 1, 28, 29, and 50 are not drawn simply to “ad books.” Instead, independent claims 1, 28, 29 and 50 are limited to “ad books . . . used by or for a recognized not-for-profit organization.”

During prosecution of the subject application, Applicant has submitted evidence from an expert in the field, Mr. Lewis Saltzman, demonstrating that an “ad book” is “a term for a charity or not-for-profit publication, such as [an] event program or honorarium, mostly filled with laudable statements by members and supporters of a group directed to the members and supporters of the group” (Affidavit of Lewis Saltzman, par. 3, (6/16/09 Amendment)). As such, the term “ad book” and especially, an ad book used by a not-for-profit organization has a very different meaning and is structurally and functionally different than the electronic book of Rothstein.

Moreover, Mr. Saltzman asserts that “I have found that the ‘ad books’ are not in the same nature as a book or novel, nor [do] they seek to insert ads or advertisements into a previously published book, work of fiction or non-fiction or any other sort of novel or book” (Affidavit of Lewis Saltzman, par. 15 (6/16/09 Amendment)). As such, an ad book is clearly different than the enhanced electronic publication of Rothstein.

With regard to the affiant, Mr. Saltzman has “been involved in the business of printing including the pre-print, producing and printing of charity and not-for-profit ‘ad books’ and similar directories and event programs since about the year 1951” (Affidavit of Lewis Saltzman, par. 2 (6/16/09 Amendment)). Mr. Saltzman is President of Saltzman Printers Inc. In addition,

“Saltzman Printers, Inc. was established around 1946 and incorporated in about 1955 and has been producing ‘ad books as a significant part of its business continuously since that time” (Affidavit of Lewis Saltzman, par. 6 (6/16/09 Amendment)). Mr. Saltzman asserts that “I and my family were instrumental in the earliest applications of ‘charity ad-books’ for group fund raising” (Affidavit of Lewis Saltzman, par. 8 (6/16/09 Amendment)). Because of Mr. Saltzman’s experience in the printing industry and in the publication of ad books in general, Mr. Saltzman is an expert in the field of ad books (Affidavit of Lewis Saltzman, par. 17 (6/16/09 Amendment)).

Moreover, those of skill in the art would not confuse the term “ad book” with the electronic book of Rothstein, with commercial publications in general or the use of advertising within those publications. In this regard, Mr. Saltzman asserts that “As one skilled in the art [of] publishing and printing of all kinds, including both books and ‘ad-books’, I do not believe that an electronic book, or book converted to an electronic format is remotely related to an ‘ad-book . . . I do not believe that they could be confused, nor that the concepts which could be described in an electronic book lead to any of the concepts of the ad-book as set forth in this declaration or in the pending patent by Bruce A. Fogelson” (Affidavit of Lewis Saltzman, par. 20 (6/16/09 Amendment)).

On another level, the “ads” of an ad book would not be confused with commercial advertising. First, “ads” contained within an ad book are mostly laudable statements. Secondly, the “ads” of the ad book constitute “most” of the ad book.

During prosecution, Applicant also submitted an Affidavit from Mr. Gerald Fogelson. (See 6/16/09 Amendment). According to Mr. Fogelson’s affidavit, “an ‘ad book’ is

similar in nature to other such charity books, directories and guide books used for fundraising for local not-for-profit groups parties or associations as a way to help raise money from members and affiliates for the not-for-profit purposes of the group as opposed to a publication with the sole commercial advertising decisions for such other books, such as coupon-books, or trade journals or such general publications as newspapers" (Affidavit of Mr. Gerald W. Fogelson, par. 9, (6/16/09 Amendment)). This evidence is corroborated by additional statements from Ms. Lori Fogelson. (Affidavit of Lori O. Fogelson (6/16/09 Amendment)). Ms. Fogelson asserts that "I am . . . very familiar with the term 'ad-book' which I take to mean a book or collection of donations which sponsor or feature congratulations, praise, and or similar laudable statements for a given charity or not-for-profit group . . . [The] general term 'ad-book' I have taken to mean the type of 'book' or collection of donation or charitable statements or 'ads' within the not-for-profit world, and not, by contrast any commercial or advertising book" (Affidavit of Lori O. Fogelson, par. 4, (6/16/09 Amendment)).

With regard to commercial advertising in general, Mr. Fogelson asserts that "I consider the commercial message, production value, image, and the value of the exposure that my advertising will have to potential target market of customers as an important factor in placing advertisements" (Affidavit of Bruce A. Fogelson, par. 11 (6/16/09 Amendment)). In contrast, Mr Saltzman asserts that "I have found that many 'ad' buyers for messages in 'ad books' do so simply desire to see their message or names in print before the group in exchange for their contribution, and seemingly have no commercial or advertising purpose" (Affidavit of Lewis Saltzman, par. 18 (6/16/09 Amendment)). Mr. Fogelson asserts that "donors to 'charity ad books' have a similar

donor's intent to one who would donate money to a contribution building fund of a not-for-profit school, hospital, library or institution to gain the recognition of having [] their name [] in or on the new building on a plaque brick or the major naming rights of naming the entire wing or building after the donor" (Affidavit of Gerald W. Fogelson, par. 11 (6/16/09 Amendment)).

In addition to having a different structure and content, ad books are also used for a different purpose and in a different way than the electronic books of Rothstein. In this regard, Mr. Saltzman asserts that "I have found that ads placed in ad books is not the same or equivalent to commercial advertising because of the differences in the content of the ad books and also because of the way that ad books are solicited, promoted or 'sold'" (Affidavit of Lewis Saltzman, par. 19 (6/16/09 Amendment)). Mr. Fogelson asserts that "I can attest that the majority, if not the vast majority of 'ads' in the 'ad-books' I am familiar with seem to me to be by people and companies or anonymously who placed these ads in the ad-book with the knowing intent that the 'ads' or messages were for not-for-profit, charity or political purposes and that these donor/advertisers were not solicited from the general public, but were members, sponsors or supporters of the group or groups members or affiliates who were solicited from the group" (Affidavit of Gerald W. Fogelson, par. 20 (6/16/09 Amendment)).

For example, Exhibit C of the Affidavit of Gerald W. Fogelson is a typical Program Ad Contract used by Roosevelt University Chicago School of Real Estate where Mr. Fogelson is a member of the board of directors (Affidavit of Gerald W. Fogelson, par. 16 (6/16/09 Amendment)). In this regard, the Program Ad Contract states that "The full amount of your contribution is tax deductible" (Affidavit of Gerald W. Fogelson, Exhibit C (6/16/09 Amendment)). Mr. Fogelson

asserts that “This statement is . . . relevant since the Program Book is not a general publication and reaches only those member of the group which are already donating to the event by attending and thus already members or affiliates, there is no commercial publication and thus no real val[u]e in relation to their cost or for any of the ads as compared to a commercial publication in a general or trade publication” (Affidavit of Gerald W. Fogelson, par. 18 (6/16/09 Amendment)).

Mr. Saltzman additionally asserts that “I have found that ‘ad books’ are produced by group volunteers who produce the ad book without pay. These group volunteers are not professionals either to the printing nor publishing nor advertising business and have tremendous turnover within the group and most, if not all, have little working knowledge of the ‘Ad Book’ process or of any commercial or non-commercial printing or publishing” (Affidavit of Lewis Saltzman, par. 13 (6/16/09 Amendment)). Mr. Saltzman also asserts that “I have found that the volunteers who produce ad books usually have very little or no experience in commercial advertising and the vast majority of the ‘ad-books’ ads are not of the type or nature of a commercial advertisement” (Affidavit of Lewis Saltzman, par. 14 (6/16/09 Amendment)). As such, a person of skill in the art of ad books would have minimal computer experience and very little or no advertising experience.

Mr. Saltzman also asserts that “I have found that the ‘ads’ or laudable statements that are solicited for ‘ad books’ are recorded manually on forms typical for that purpose and taken by the volunteers onto paper forms, which then need to be pre-print processed into ‘ads’ or messages suitable for pagination and printing. Other than the proposed invention by Bruce A. Fogelson, I have never seen an electronic or automated form that can expedite this for process, either for the

group soliciting or for a printer, such as us. This invention would represent a novel and useful tool to my view as an expert in the field" (Affidavit of Lewis Saltzman, par. 17 (6/16/09 Amendment)). As such, the prior art has taught away from the claimed invention.

Moreover, there has been a long-felt need for a better method of producing ad books. For example, "Even as technology has advanced in the printing industry, it is my professional opinion, that the 'ad book' type pre-print and production and the charity methods solicitations of such laudable statements and the overall concepts has remained the same, with no significant change, and has lagged frustratingly behind, both as a way for an organization raise money for its cause and as a way for an organization to provide better pre-print production or printing . . . The exception to this is my introduction to the 'Ad Book process . . . by Bruce A. Fogelson in 2006" (Affidavit of Lewis Saltzman, par. 11 (6/16/09 Amendment)).

As set forth above, Rothstein fails to provide any teaching or suggestion of an ad book. As noted above, a person of skill in the art would not confuse a Rothstein publication with an ad book. Moreover, a contributor to an ad book is motivated by entirely different reasons than an advertiser in a Rothstein type publication. The Rothstein advertiser is motivated by profit and the contributor is motivated by charity and/or a need for recognition.

The evidence submitted by Applicant establishes that the electronic books of Rothstein are structurally and functionally different than the ad books of the claimed invention. Moreover, the claims are not directed to ad books per se. Instead, the claims are directed to methods and apparatus for creating ad books. The fact that an ad book may contain printed matter and that printed matter may not, by itself, constitute patentable subject matter does not mean that it can be

ignored in applying the Section 103 standard of obviousness. More to the point however is that “Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare that the remaining portion of the mutilated claim is unpatentable” (In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). Since Rothstein is directed to advertising and not ad books and since the structure and method of Rothstein, in general, are different than the claimed invention, the rejections are improper. Since the rejections are improper, they should be overturned.

The Office Action asserts (“Official Notice”) that “Street News” is a local publication published by an organization in New York on behalf of the homeless . . . The organization solicits and receives ads from advertisers or supporters, supporting the Homeless cause, and the advertisers’ messages are placed or displayed in the newspapers that is distributed and sold to the public at large and the advertisers or supporters are billed for placing their ads in the newspaper (receiving a pledge or contribution from a supporter or advertiser for agreeing to place an ad in the ‘Street News’ newspaper or ad-book” (Office Action of 12/22/08, page 9). The difficulty with this assertion however is that there is no identifiable organization (other than the newspaper) that solicits the ads and it appears that the solicitation is, in fact, by the newspaper on a for-profit basis. If the Examiner believed otherwise, then the Examiner should have cited a reference or other publication (as required) that establishes such facts.

In the Response filed on 6/16/09, the Applicant challenged the Official Notice as required under MPEP §2144.03(C). MPEP §2144.03(C) requires that “If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action.” The Examiner has not met this burden.

The Office Action makes vague reference to “Special” cards to raise funds for the needed. However, such references appear to be completely without basis. If the Examiner believed that these references teach some aspect of an ad book, then the Examiner should have cited a reference or other publication (as required) that establishes such facts.

The Office Action makes reference (page 10) to church bulletins (e.g., Holy Name Church, located in New York City) that have displayed in the back portions announcements and advertisements on behalf of local advertisers or supporters for an advertising fee and the revenues raised through this process help cover the churches overhead cost. However, once more, there is no basis for these assertions. Do the bulletins contain mostly laudatory statements? Are they distributed at some event? If the Examiner believes that these are ad books, then the Examiner should have cited a reference or other publication (as required) that establishes such facts.

The Office Action assert that it is common practice to download tools to create advertisements. However, these statements are without basis. If the Examiner believes otherwise, then the Examiner should have cited a reference or other publication (as required) that establishes such facts.

The Examiner has failed to establish any credible basis why one skilled in the art would have been led by the relevant teachings of the applied references to make the claimed invention. For the foregoing reasons, allowance of claims 1-58 as now presented, is believed to be in order. It is respectfully requested that this Board reverse the decision of the Examiner in all respects.

Respectfully submitted,

HUSCH BLACKWELL SANDERS
WELSH & KATZ

By:



Jon R. Christensen
Registration No. 34,137

Dated: May 27, 2010

HUSCH BLACKWELL SANDERS
WELSH & KATZ
120 South Riverside Plaza, 22nd Floor
Chicago, Illinois 60606
(312) 655-1500

VIII. APPENDIX OF THE CLAIMS

1. (Rejected) A method for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations, for charity or fund raising, whereby members or supporters of the organization publish or place or manage an ad or ads or a message or messages in the organization's publication, such method comprising:

 a member, supporter or contributor at a user terminal connected to a communications network accessing an advertising preparation tool or computer program within an ad-book server or communication network;

 the member, supporter or contributor preparing an ad or message using the advertising preparation tool or computer program;

 receiving a pledge or contribution from the member, supporter or contributor on behalf of the recognized not-for-profit organization; and

 processing the ad or message at the server connected to the communications network for placing the ad or message in an ad-book or related print publication where the ad-book or related print publication is a fundraising vehicle and the governmentally recognized not-for-profit organizations, members or supporters of the organization solicit for or place the ads or messages to make contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the governmentally recognized not-for-profit organization, its activities or its members or its mission or cause.

2. (Rejected) The method of claim 1 wherein preparing further comprises selecting choices relating to the ad or message.

3. (Rejected) The method of claim 2 wherein choices comprises size, placement, color, price, background, font, image or layout.

4. (Rejected) The method of claim 2 wherein choices comprises indicating whether the ad or message shall be printed in a physical ad-book or related publication or shall be posted on an on-line ad-book posted on an Internet web site as opposed to a physically printed publication or wherein the choice comprises whether the ad or message shall be both printed in a physical ad-book or related print publication and also posted on-line on an Internet web site.
5. (Rejected) The method of claim 1 wherein preparing further comprises selecting an advertisement type or theme to reduce the number of choices that an advertiser must make to produce an ad or message.
6. (Rejected) The method of claim 1 wherein the communications network comprises a public switch telephone network and packet data network.
7. (Rejected) The method of claim 1 wherein the user terminal comprises a computer system.
8. (Rejected) The method of claim 7 wherein the computer system comprises one of a personal computer, a notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant.
9. (Rejected) The method of claim 1 wherein the server comprises a web server computer system for accessing the communications network.
10. (Rejected) The method of claim 9 wherein the web server comprises a firewall for maintaining security.
11. (Rejected) The method of claim 10 wherein the firewall limits access to information on the server wherein information comprises the ads or message and the ad-books.

12. (Rejected) The method of claim 1 wherein preparing further comprises using computer software running at the user terminal to create an ad or message.

13. (Rejected) The method of claim 12 wherein the computer software comprises at least one of Microsoft Office, Corel PageMaker and Adobe PhotoShop.

14. (Rejected) The method of claim 1 wherein processing further comprises receiving payment at the server for processing the ad or message for placement in an ad-book.

15. (Rejected) The method of claim 1 wherein processing further comprises: receiving the ads or messages at the server from the user terminal; storing the ads or messages at the server; and converting the received ads or message into an ads or message to be placed into an ad-book or related print or publication.

16. (Rejected) The method of claim 15 further comprising receiving payment at the server for processing the ad or message for placement in an ad-book or related print or publication.

17. (Rejected) The method of claim 15 further comprising classifying the received ad or message into an ad-book or related print or publication category said classification based upon amount contributed to the recognized not-for-profit organization or by color of a page to be printed selected from the group consisting of gold, silver and white or by a size of the ad selected from the group consisting of full-page, one-half page, one-quarter page, business card size and simple listing of name or contact information.

18. (Rejected) The method of claim 15 further comprising using techniques, the techniques comprising statistics and demographics, to discern at least one group of related ads or messages said discernment based upon amount contributed to the recognized not-for-profit organization or by color of a page to be printed selected from the group consisting of gold, silver and white or by a

size of the ad selected from the group consisting of full-page, one-half page, one-quarter page, business card size and simple listing of name or contact information.

19. (Rejected) The method of claim 15 further comprising comprising using statistics and demographics, to discern at least one group of related organizations, members or supporters which place ads or messages in ad-books or related print or publications.

20. (Rejected) The method of claim 15 further comprising using statistics and demographics, to discern at least one group of related ad-books.

21. (Rejected) The method of claim 15 further comprising converting the received "ad" or message into an HTML advertisement to be shown on at least one user terminal.

22. (Rejected) The method of claim 21 wherein the HTML ad or message is a part of an electronic ad-book.

23. (Rejected) The method of claim 21 further comprising sending a copy of the HTML ad or message to a member or supporter whom initiated the ad or message preparation.

24. (Rejected) The method of claim 1 further comprising registering with the server whereby a member or supporter at the user terminal connects to the server and enters information relating to the member or supporter.

25. (Rejected) The method of claim 1 further comprising entering a mode of payment at the user terminal to pay for the ad or message to be placed in the ad-book or related print or publication.

26. (Rejected) The method of claim 1 further comprising sending an acknowledgement to an member and/or supporter who places an ad or message in an ad-book or related print or publication notifying the member or supporter of the receipt of the ad or message.

27. (Rejected) The method of claim 1 further comprising sending an acknowledgement to an member or supporter who places an ad or message in an ad-book or related print or publication notifying the member or supporter of payment information.

28. (Rejected) A method for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations for charity or fund raising, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization's publication, the method comprising:

 a member, supporter or contributor at a user terminal connected to a communications network accessing an advertising preparation tool or computer software system within a server or communication network;

 the member, supporter or contributor preparing an ad or message by selecting choices provided by the advertising preparation tool or computer software system related to the ad or message;

 receiving the prepared ad or message at the server connected to the communications network;

 classifying the prepared ad or message into at least one ad-book;

 means for receiving a contribution from the contributor on behalf of the governmentally recognized not-for-profit organization; and

 converting the prepared ad or message into an ad or message to be placed into an ad-book or related print publication where the ad-book or related print publication is a fundraising vehicle and the recognized not-for-profit organization's members or supporters of the organization solicit for or place the ads or messages to make financial pledges or contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the recognized not-for-profit organization, its activities or its members.

29. (Rejected) A system for preparing computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for recognized not-for-profit organizations for charity or fund raising and as a fundraising tool, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization's publication, such system comprising:

an advertising preparation tool or software program within an ad-book server accessible by a contributor through a communication network;

means used by the contributor for preparing an ad or message at a user terminal connected to the advertising preparations tool or software program through the communications network; and

means for receiving a financial pledge or contribution from the contributor on behalf of the recognized not-for-profit organization;

means for processing the ad at a server connected to the communications network for placing the advertisement in the ad-book or related print publication where the ad-book or related print publication is primarily a fundraising vehicle and the recognized not-for-profit organizations, members or supporters of the organization solicit for or place the ads or messages to make pledges or contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the recognized not-for-profit organization, its activities or its members or cause or mission.

30. (Rejected) The system of claim 29 wherein the means for preparing further comprises means for selecting choices relating to the ad or message.

31. (Rejected) The system of claim 30 wherein choices comprises size, price, placement, background and layout.

32. (Rejected) The system of claim 30 wherein choices comprises indicating whether the ad or message shall be printed in a physical ad-book or related print or publication or shall be posted on an on-line ad-book posted on an Internet web site as opposed to physically printed publication or wherein the choice comprises whether the ad or message shall be both printed in a physical ad-

book or related print or publication and also posted on-line on the Internet web site in an on-line ad-book.

33. (Rejected) The system of claim 29 wherein the means for preparing further comprises means for selecting an ad or message type, price or theme to reduce the number of choices that a member or supporter makes to produce an ad or message.

34. (Rejected) The system of claim 29 wherein the communications network comprises a public switch telephone network and packet data network.

35. (Rejected) The system of claim 29 wherein the user terminal comprises a computer system.

36. (Rejected) The system of claim 35 wherein the computer system comprises one of a personal computer, notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant.

37. (Rejected) The system of claim 29 wherein the server comprises a web server computer system for accessing the communications network.

38. (Rejected) The system of claim 37 wherein the web server comprises a firewall for maintaining security.

39. (Rejected) The method of claim 38 wherein the firewall limits access to information on the server wherein information comprises the ads or message and ad-books or related print or publication.

40. (Rejected) The system of claim 29 wherein the means for preparing further comprises means for using computer software to create an ad or message.

41. (Rejected) The system of claim 40 wherein the computer software comprises at least one of Microsoft Office, Corel PageMaker and Adobe PhotoShop.

42. (Rejected) The system of claim 29 wherein the means for processing further comprises receiving payment at the server for processing the ad or message for placement in an ad-book or related print or publication.

43. (Rejected) The system of claim 29 further comprising means for converting the ad or message into an HTML ad or message to be shown on at least one user terminal.

44. (Rejected) The system of claim 43 wherein the HTML “ad” or message is a part of an electronic ad-book or related print or publication.

45. (Rejected) The system of claim 43 further comprising means for sending a copy of the HTML ad or message to an a member or supporter whom initiated the “ad” or message solicitation or preparation.

46. (Rejected) The system of claim 29 further comprising means for registering with the server whereby a member or supporter at the user terminal connects to the server and enters information relating to the member or supporter.

47. (Rejected) The system of claim 29 further comprising means for receiving the ad or message from a member or supporter.

48. (Rejected) The system of claim 47 further comprising means for sending an acknowledgement to the member or supporter notifying the member or supporter of the receipt of the ad or message.

49. (Rejected) The system of claim 47 further comprising means for sending an acknowledgement to the member or supporter notifying the member or supporter of payment information.

50. (Rejected) A system for computerized/automated preparation, production, publishing and management of ad-books and related print or publishing used by or for a recognized not-for-profit organizations, for charity or fund raising, whereby organizations, members or supporters of the organization place or manage ads or messages in the organization's publication over the Internet, the system comprising:

 a computer system comprising a user interface to a communications network and an advertising preparation tool within an ad-book server accessed by the user interface through the communications network to prepare an ad or message and to receive a contribution on behalf of the organization; and

 the ad-book server connected to the communications network that receives the prepared ad or message for an ad-book or related print or publication where the ad-book or related print publication is a fundraising vehicle and the organizations, members or supporters of the recognized not-for-profit organization solicit for or place the ads or messages to make contributions to the organization and wherein at least some of the ads or messages in the ad-book or related print publication contain laudatory statements about the governmentally recognized not-for-profit organization, for charity or fund raising, its activities or its members.

51. (Rejected) The system of claim 50 wherein the computer system further comprises a graphical user interface for selecting choices relating to the ad or message.

52. (Rejected) The system of claim 51 wherein choices comprises size, placement, color, price, background, and layout.

53. (Rejected) The system of claim 50 wherein the ad-book server presents choices relating to an ad or message type or ad or message theme to the computer system.

54. (Rejected) The system of claim 50 wherein the communications network comprises a public switch telephone network and packet data network.

55. (Rejected) The system of claim 50 wherein the computer system further comprises one of a personal computer, a notebook computer, a personal digital assistant (PDA), a cellular telephone or a mobile/wireless assistant.

56. (Rejected) The system of claim 50 wherein the ad-book server further comprises a web server computer system capable of interfacing with the Internet.

57. (Rejected) The system of claim 50 wherein the computer system further comprises at least one of Microsoft Office, Corel PageMaker, and Adobe PhotoShop.

58. (Rejected) The system of claim 50 wherein the ad-book server further comprises a database of at least one of ads or messages, ad-books or related print or publications, and organizations, members or supporters.

No evidence has been submitted with the appeal.

X.

RELATED PROCEEDINGS INDEX

There are no proceedings related to this appeal.